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10/039,326	11/07/2001	Richard Tiffin	RTIFFIN-1X	1491

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EXAMINER

LEGESSE, NINI F

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/039,326

Applicant(s)

TIFFIN, RICHARD

Examiner

Nini F. Legesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

**Applicant's Request for Continuing Examination, amendment to claims 1-5, and cancellation of 12-19 is acknowledged in paper no. 11.**

#### ***Specification***

The disclosure is objected to because of the following informalities: page 10, lines 1-5 indicate item (20) as a mark-retaining surface and as a base element at the same time.

Page 10, lines 1-11 discloses that the NCR paper (20) is to be secured to the sheet of the durable resilient material (18) but not to the base (12) as shown on Fig. 4.

Appropriate correction is required.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12" and "14" have both been used to designate a base and a rubber mat.

The specification as disclosed on pages 9-10 appear to indicate that the NCR paper (20) is to be secured to the base element (12) while the Figures (for example Fig. 4) indicate that item (20) secured to item (18).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1, 7, 9, and 11** are indefinite because claim 1 recites the limitation "said firm support layer" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,984,802).

Perrine discloses a golf swing practice mat (110) comprising:

- A rigid support layer (117);
- Mark retaining surface means (112, item 112 is clearly capable of "recording" an impression when hit by a golf club with emphasis on resilient surface 114; see also col. 6, lines 24-32); and
- Retaining means (see column 6, lines 45+).

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**Claim 2** is rejected under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,984,802).

Perrine discloses a golf swing practice mat (110) comprising:

- A firm support layer (150, see also col. 6 lines 45+);
- Mark retaining surface means (112, item 112 is clearly capable of “recording” an impression when hit by a golf club with emphasis on resilient surface 114; see also col. 6, lines 24-32);
- Retaining means (see column 6, lines 45+); and
- Rubber mat (114).

**Claims 4 and 5** are rejected under 35 U.S.C. 102(b) as being anticipated by Perrine.

Perrine discloses Wherein said rubber mat is secured to said firm support layer by adhesives (column 5, lines 39-40 indicate that the bottom pad and the top sheet could be adhesively bonded); and wherein said firm support layer (150) includes a substantially planar sheet of plastic (column 6, lines 45-62 indicate that strip 150 could be plastic material);

**Claim 11** is rejected under 35 U.S.C. 102(b) as being anticipated by Perrine.

Perrine discloses wherein said mark retaining surface means comprise a wax containing surface (column 6, line 27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine. Perrine discloses the invention as recited above but fails to explicitly state wherein the rubber mat is secured to the firm support layer by adhesive tape. However, Perrine teaches that the base element and the mat could be secured with a screw or could be thermally or adhesively bonded (column 5, lines 34-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive tape since it was known in the art that an adhesive tape could easily secure different elements together.

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine. Perrine teaches that the top sheet (12, 112) has a completely smooth and very low-friction surface that is made of a suitable type plastic (column 6, lines 44-46). However, he fails to teach that this planar sheet of plastic to be polycarbonate plastic and the retaining means to comprise fastening dowels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the apparatus of Perrine with polycarbonate plastic or any other compatible plastic since Applicant has not shown the criticality for the claimed polycarbonate element. It appears that the practice mat of Perrine would accomplish similar purpose. And those skilled in

the art may use a variety of plastics for the top sheet without departing from the spirit and scope of Perrine's invention.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Manheck (US patent No. 3,754,764).

Perrine discloses wherein the mark retaining means (12, 112) has a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing through the hitting area when the club head is in contact with the top sheet (column 6, lines 24-32). These elements appear to be no carbon elements. Perrine also discloses the use of multiple ball positions (30) on the mat (column 5, lines 65-67). However Perrine fails to teach the presence of a sheet of no carbon paper. However, Manheck teaches about no carbon paper (column 2, lines 14-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a no carbon paper as taught by Manheck in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a no carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

**Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436).

Perrine discloses that markings are provided on the top sheet for ball positions (column 5, lines 42-50). He also teaches that the top sheet (12, 112) to have a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the

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actual path of a golf club's head passing through the hitting area when the club head is in contact with the top sheet (column 6, lines 24-32). However Perrine fails to teach the presence of a sheet of carbon paper. However, Grossman teaches about carbon paper (41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a carbon paper as taught by Grossman in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

**Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Miller (US patent No. 5,028,052).

Perrine as discussed above discloses a firm support layer (150, see also col. 6 lines 45+); a mark retaining surface means (112, item 112 is clearly capable of "recording" an impression when hit by a golf club with emphasis on resilient surface 114; see also col. 6, lines 24-32); a retaining means (see column 6, lines 45+); and a rubber mat (114). However, for sake of discussion, if one believes that the Perrine's reference is different than the instant invention in that item 150 could not be considered a support layer and that the rubber mat element is to be secured to the bottom of the support layer, then the teaching of the Miller reference can be combined with the Perrine's reference. Miller discloses base member (10, col. 2, line 50 indicates the base member to be polycarbonate material) that is positioned between a golf ball hitting surface (20) and a base member (10). In addition, the Miller reference includes rubber-like supports/mats



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(14) that are adhesively bonded to the base (col. 2, lines 60-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide different arrangement of golf mat components as taught by Miller in the Perrine's device in order to provide the feel of natural turf as the club head strikes a golf ball placed on hitting surface.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 9, 11, and 12-19 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

NFL  
01/05/04

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
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